

### **REMARKS**

Claims 2-20 are pending in this application. Claims 7 and 14 are independent claims.

By this amendment, claims 9 and 12 are amended to correct minor informalities contained therein, and the title of the invention is amended.

Reconsideration in view of the above amendments and following remarks is respectfully solicited.

#### **Allowable Subject Matter**

Applicants gratefully acknowledge the Examiner's indication of allowable subject matter in claims 2-13 over the art of record.

However, applicants respectfully submit that all of claims 2-20 are allowable, for at least the reasons set forth below.

#### **The Claim Objections are Obviated**

The final Office Action objects to claims 9 and 12 for minor informalities contained therein. This objection is respectfully traversed.

Applicants respectfully submit that the amendment to claim 9 and 12 obviates the objection of the claims. In particular, claims 9 and 12 are amended in accordance with the Examiner's suggestions of page 2 of the final Office Action.

Accordingly, withdrawal of the objection to claims 9 and 12 is respectfully solicited.

#### **Shimizu is Disqualified as Prior Art under 103(a)**

The Final Office Action indicates that:

Claims 14-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,567,125 to Shimizu (hereafter Shimizu) in view of U.S. Patent No. 5,008,757 to Kimura et al. (hereafter Kimura).

This rejection is respectfully traversed.

Applicants respectfully submit that Shimizu should be disqualified as “Prior Art” because according to MPEP §706.02(l)(1): subject matter which was prior art under former 35 U.S.C. 103 *via* 35 U.S.C. 102(e) is now *disqualified as prior art* (emphasis added) against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” An application filed on or after November 29, 1999, with the required evidence of common ownership, will serve to exclude commonly owned 35 U.S.C. 102(e) prior art that was applied, or could have been applied, in a rejection under 35 U.S.C. 103 in the parent application.

As such, applicants respectfully submit that because the present application was filed after November 29, 1999 and both the present application and Shimizu are commonly owned by Fuji Photo Film Co., Ltd., and the required evidence of common ownership is shown in the Assignment papers filed on April 5, 2001 in the present application, depicting “Fuji Photo Film Co., Ltd.” as the common owner between the present application and the cited Shimizu (USP 6,567,125) reference, the 102(e) reference Shimizu should be disqualified as “Prior Art” under 103(a), as presently being applied by the Examiner.

In other words, both the present Application 09/826,002 and Patent 6,567,125 were, at the time the invention of Application 09/826,002 was made, owned by “Fuji Photo Film Co., Ltd.”.

Accordingly, applicants respectfully submit that the primary reference being used by the Examiner, i.e., USP 6,567,125 (Shimizu), under the 103(a) rejection in the final Office Action is now *disqualified as prior art* against the claimed invention.

Furthermore, applicants respectfully submit that the secondary reference, i.e., USP 5,008,757 (Kimura), fails to make up for the disqualification of USP 6,567,125 (Shimizu).

Applicants respectfully submit that claims 14-20 are now allowable due at least to the disqualification of the primary reference Shimizu.

Accordingly, withdrawal of the rejection of claims 14-20 under 35 U.S.C. §103(a) is respectfully requested.

### Conclusion


In view of the foregoing, Applicants respectfully submit that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 **to schedule a Personal Interview.**

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

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Respectfully submitted,

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